



THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Goodman et al.

Serial No. 08/971,172

Filed: November 14, 1997

For: *Robo: A Novel Family of
Polypeptides and Nucleic Acids*

Group Art Unit: 1647

Examiner: Turner, S.

Attorney Docket No. B98-006-2

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Signed

Richard Osman

REPLY BRIEF ON APPEAL

The Honorable Board of Appeals and Interferences
United States Patent and Trademark Office
Washington, D.C. 20231

Dear Honorable Board:

Our Reply Brief is responsive to the Examiner's Answer mailed October 1, 2002.

We submit that the Answer is part of an illegal discriminatory examination procedure established by Examiners Kunz and Turner, of which we have repeatedly complained, and the Answer is non-compliant with 35USC132(a) and 37CFR1.193(a)(2) because it introduces into the record and relies on new evidence, which Applicants have not had an opportunity to consider. The Examiner may not introduce into the record and rely on any new evidence in an Examiner's Answer. Furthermore, this new evidence may not be considered by the Board, as Applicant has been afforded no opportunity to address and rebut this new evidence.

Until Applicants have had an opportunity to address and rebut this newly proffered evidence, this record, at least as applied to the prior art rejections, is not ripe for Board review. We have simultaneously petitioned to the Commissioner to rescind this facially improper Answer (appended hereto). However, to the extent the Board nevertheless elects to review this rejection without Applicants having had any opportunity to respond with rebuttal evidence, we maintain that the rejections are improper even in the absence of rebuttal evidence.

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This application was filed over five years ago. The Office issued a first Action on the merits on 3/5/99, and we responded on 5/18/99. The Office issued a second, final Action on 10/14/99, and we responded on 11/12/99. Examiner Turner then issued a third, non-final action on 1/21/00, and we responded on 2/7/00. She issued a fourth, non-final Action on 5/10/00, and we responded on 8/31/00. She then sent a sequence listing Notice on 12/11/00, and we responded on 1/5/01. She sent a fifth, non-final Action on 3/27/01, and we responded on 7/13/01. She then sent a sixth, final Action on 10/10/01. It is from this final Action which we are now attempting to appeal.

The Answer withdraws rejection of claim 104 under 35USC112, first paragraph and withdraws the rejection of claims 108-110 under 35USC102(a). Accordingly, the claims and issues remaining before the Board are as follows.

STATUS OF THE CLAIMS

Claims 68-91 and 93-119 are pending and subject to this appeal.

ISSUES REMAINING IN APPEAL

- I. THE PROPRIETY OF THE EXAMINER'S REJECTION OF CLAIMS 68-91 AND 93-119 UNDER 35USC101, AS MADE IN THE ACTION DATED 10/10/01
- II. THE PROPRIETY OF THE EXAMINER'S REJECTION OF CLAIMS 68-91 AND 93-119 UNDER 35USC112, FIRST PARAGRAPH, AS MADE IN THE ACTION DATED 10/10/01
- III. THE PROPRIETY OF THE EXAMINER'S REJECTION OF CLAIMS 81, 100, 102-103 AND 113-114 UNDER 35USC112, FIRST PARAGRAPH, AS MADE IN THE ACTION DATED 10/10/01
- IV. THE PROPRIETY OF THE EXAMINER'S REJECTION OF CLAIMS 88-90 UNDER 35USC102(a), AS MADE IN THE ACTION DATED 10/10/01

V. THE PROPRIETY OF THE EXAMINER'S REJECTION OF CLAIMS 94-95 UNDER 35USC103(a), AS MADE IN THE ACTION DATED 10/10/01

GROUPING OF THE REMAINING CLAIMS

For issue I, claims 68-71, 73-74; 79-81, 83-84, 88-91, 94-95, 100-103, 106-107, 112-114, 116-117 shall stand as a separate group; and claims 72, 78, 82, 87, 93, 99, 105, 111, 115 shall stand as a separate group.

For issue II, claims 68-71, 73-74; 79-81, 83-84, 88-91, 94-95, 100-103, 106-107, 112-114, 116-117 shall stand as a separate group; and claims 72, 78, 82, 87, 93, 99, 105, 111, 115 shall stand as a separate group.

For Issue III, claim 81 shall stand separately; claims 100, 102-103 shall stand as a separate group; claim 113 shall stand separately; and claim 114 shall stand separately.

For Issue IV, the rejected claims shall stand as a group.

For Issue V (previously Issue VI), the rejected claims shall stand as a group.

RESPONSE TO EXAMINER'S ANSWER

I. THE EXAMINER'S REJECTION OF CLAIMS 68-91 AND 93-119 UNDER 35USC101, AS MADE IN THE ACTION DATED 10/10/01, IS IMPROPER.

The Answer continues to misconstrue the claims to require that the reagents serve to diagnose or treat disease. No such requirement is present in the claims. As repeatedly used in the specification, the probes are diagnostic of the presence of Robo transcripts and protein; e.g. p.3, lines 12-13. These probes are as industrially useful as any equipment or reagents used in commercial research. For example, specific antibodies diagnostic of the presence of nerve guidance molecules are commercially bought, sold and licensed. A demonstrably active, present, real-world commercial market for the invention demonstrates industrial utility of the invention.

II. THE EXAMINER'S REJECTION OF CLAIMS 68-91 AND 93-119 UNDER 35USC112, FIRST PARAGRAPH, AS MADE IN THE ACTION DATED 10/10/01 IS IMPROPER.

For this rejection, the Examiner merely relies on her prior "utility" rejection. Again, the

Examiner is misconstruing the claims to require diagnosing disease. In fact, our claims relate to probes to locate and trace molecules that regulate nerve growth: probes that are bought and sold in commerce; probes that have a demonstrably active, present, real-world commercial market; probes that have unequivocal industrial utility.

III. THE EXAMINER'S REJECTION OF CLAIMS 81, 100, 102-103 AND 113-114 UNDER 35USC112, FIRST PARAGRAPH, AS MADE IN THE ACTION DATED 10/10/01 IS IMPROPER.

Our Specification discloses all the recited protein and corresponding polynucleotide sequences (SEQ ID NOS:1-12). Our Specification teaches that the invention includes incomplete translates and deletion mutants of the recited sequences (p.4, lines 6-8). Each recited incomplete translate is separately disclosed in the application as filed. Where the Specification teaches polynucleotides encoding the recited polypeptides, showing all corresponding polypeptide-encoding polynucleotides, the Specification inescapably teaches polynucleotides encoding any particularly recited polypeptide. The alternative is to have the Specification re-recite a separate polynucleotide fragment for each recited polypeptide fragment - even though the full polypeptide-encoding polynucleotide sequence, with full codon-amino acid correspondence, has already been provided. The Examiner's position is so scientifically preposterous that it can derive only from the aforementioned illegal examination procedure of Examiners Turner and Kunz.

IV. THE EXAMINER'S REJECTION OF CLAIMS 88-90 UNDER 35USC102(a), AS MADE IN THE ACTION DATED 10/10/01 IS IMPROPER.

Apparently realizing that their rejections lack substantiation, Examiners Kunz and Turner remarkably seek to introduce in their Answer, for the first time, new evidence to support their rejection. Ironically, this new evidence in fact further undermines their position. However, neither we nor the Board are able to consider the Examiners' newly proffered evidence at this time. If the Examiners wish to rely on new evidence to support their rejection, they may not introduce it for the first time in their Answer. Applicants have had no opportunity to confront or rebut, and the Board may not consider unvetted evidence. As noted above, we have

simultaneously petitioned to the Commissioner to rescind this facially improper Answer. However, to the extent the Board nevertheless elects to review this rejection without Applicants having had any opportunity to respond with rebuttal evidence, we maintain that the rejection is improper even in the absence of rebuttal evidence. Furthermore, the Answer is deceptive.

The creation date of an EMBL or GenBank record is not the public availability date. The creation date is the date the record was originally created. Frequently, these records are maintained in secrecy until a predetermined publication or patent filing date is effected. Furthermore, the record at the creation date does not often reflect the record as subsequently accessed. Like most electronic databases, Genbank and EMBL are constantly updating, amending, annotating and otherwise supplementing their records. These newer "editions" retain the creation date of the original record, but were obviously not in existence at that date. Here, the Examiner seeks to rely on a creation date for a record that could not logically have existed on that creation date. A document (electronic or otherwise) that makes explicit reference to dates and events in Apr 1997 and Mar 2000 could not logically have been "published" or made "publicly available" in Feb 1997.

The "publication date" of a reference for the purposes of 35USC102 is the date that the cited information was in fact available to the interested public. The U88183 record has been regularly updated with new annotations since its initial creation. These updates include the annotations of the relevant open reading frames defined by records 1825710 and 1825711. To the extent the Examiner seeks to rely on these annotations, the relevant "publication date" is the date the annotations were made - not the prior creation date of the U88183 record, which at that time did not and logically could not contain reference to the subsequently identified 1825710 and 1825711 reading frames.

Finally, but for witnessing a long history of misrepresentations from Examiners Kunz and Turner (which are of record in our various petitions), we would be surprised by their present effort to mislead the Board. Note that their rejection is premised on their allegation of a 2-14-97 publication date. They now allege that they substantiated this alleged publication date by communication directly with the depository (Answer, p.12, line 15 - p.13, line 2). They repeatedly allege a publication date of "2-14-97", but with a not-too-subtle hand wave, note that their new evidence confirms that the publication date was "prior to April 1997". Why do they

not mention that their new evidence in fact undermines there allegation of a 2-14-97 publication date with yet another unexplained and inconsistent date: 2-7-97? Why do they substitute the uncomfortable "2-7-97" with "prior to April 97"? Are they not forthright enough to expressly acknowledge to the Board that their newly proffered evidence is in fact inconsistent with their allegation of a 2-14-97 publication date? The Examiner is not telling an outright lie, but she is strategically creating a misleading record, which is contrary to the mission of the USPTO.

We do not know what was published on 2-7-97 and we do not know what was published on 2-14-97. However, we do know that whatever, if anything, was published on those dates, it could not logically have included references to open reading frames which had not yet been identified.

V. THE EXAMINER'S REJECTION OF CLAIMS 94-95 UNDER 35USC103(a), AS MADE IN THE ACTION DATED 10/10/01 IS IMPROPER.

The Examiner apparently has not yet realized that U88183 is the sequence of X chromosome cosmid ZK377, and its annotations, which were subject to numerous updates, including predicted open reading frames 1825710 and 1825711. The Examiner continues to defy logic by suggesting that the annotations to these reading frames (1825710 and 1825711) existed in the U88183 record prior to the identification of these reading frames.

We petition for and authorize charging our Deposit Account No.19-0750 all necessary extensions of time. The Commissioner is authorized to charge any fees or credit any overcharges relating to this communication to our Dep. Acct. No.19-0750 (order B98-006-2).

Respectfully submitted,
SCIENCE & TECHNOLOGY LAW GROUP



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cc. Petition to Rescind Answer (2p).